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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/557,804	04/25/2000	Roger Bruce Harding	1313/1F022-US1	8941

7590 09/18/2002
Darby & Darby PC
805 Third Avenue
New York, NY 10022

EXAMINER

WHITE, EVERETT NMN

ART UNIT	PAPER NUMBER
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1623

DATE MAILED: 09/18/2002

14

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/557,804

Applicant(s)

HARDING ET AL.

Examiner

EVERETT WHITE

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 June 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-64 is/are pending in the application.
- 4a) Of the above claim(s) 1-38 and 40-59 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 39 and 60-64 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 12 & 13. 6) ☐ Other:

DETAILED ACTION

1. Amendment A filed June 4, 2002 has been received and entered into the record.
2. Claims 1-64 are pending in the case.

Election/Restrictions

3. Applicant's election with traverse of Group II, Claims 39-46 in Paper No. 11 is acknowledged. The traversal is on the ground(s) that the product recited in the claims of Group II is made by the process recited in the claims of Group I and III and, optionally, with the cellulose floc recited in the claims of Group III. This is not found persuasive because prosecution of all the inventions disclosed in this application, along with carrying out searches for all the different types species, would present an undue burden on the Examiner. However, should the products of Group II be in condition for allowance Group I will be rejoined. Only claims that are directed to preparing the allowed product and which are commensurate in scope would be rejoined.

Applicants also argue that claims 43-46 should be examined since these claims are directed to carboxymethyl celluloses derived from various types of pulps. These claims will be rejoined if the carboxymethyl cellulose of Claim 39 is found to be in condition for allowance.

The requirement is still deemed proper and is therefore made FINAL.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein

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were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
 2. Ascertaining the differences between the prior art and the claims at issue.
 3. Resolving the level of ordinary skill in the pertinent art.
 4. Considering objective evidence present in the application indicating obviousness or nonobviousness.
5. Claims 39 and 60-64 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mansikkamaki et al (EP 0879827, already of record).

Applicants claim a carboxymethyl cellulose ether prepared by a method that involved (a) obtaining mercerized and recovered cellulose pulp; and (b) converting the mercerized and recovered cellulose pulp into carboxymethyl cellulose.

The Mansikkamaki et al patent discloses carboxymethyl cellulose that may be derived from sulphite softwood pulp (see page 2, line 14), which embraces the softwood kraft cellulose pulp used in the preparation of instant Claims 39 and 60-64. Mansikkamaki et al also shows that mercerization of cellulose pulp during preparation of carboxymethyl cellulose is known in the art (see page 2, lines 18-21). The Mansikkamaki et al patent sets forth, in Table 2 on page 3 of the document, viscosity values for the carboxymethyl cellulose thereof that are greater than 12 cP, which embraces the viscosity values disclosed in the instant claims. The carboxymethyl cellulose ether of the instant claims differs from the carboxymethyl cellulose of the Mansikkamaki et al patent by setting forth the instant claims in product-by-process forms. However, process limitations cannot impart patentability to a product that is not patentably distinguished over the prior art. The instantly claimed carboxymethyl cellulose ether product, per se, does not appear to indicate characteristics that make

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the product different and therefore patentable over the carboxymethyl cellulose ether product of the Mansikkamaki et al patent. Accordingly, it would have been obvious to one of ordinary skill in the art at the time of applicant(s) invention having the Mansikkamaki et al patent before him to employ the carboxymethyl cellulose ether thereof in view of their closely related structures and the resulting expectation of similar thickening and stabilizing properties.

6. Applicant's arguments with respect to claims 39 and 60-64 have been considered but are moot in view of the new ground(s) of rejection.

Response to Arguments

7. Applicant's arguments filed June 4, 2002 have been fully considered but they are not persuasive. Applicants argue that the Mansikkamaki patent does not state how the 2% viscosity is measured. This argument is not persuasive since the Mansikkamaki patent discloses a preparation of the carboxymethyl cellulose that involves mercerization of the cellulose pulp before the etherification step, which embraces the process steps of the instant claims. The similar process conditions would suggest similar viscosity values. The Mansikkamaki also discloses that the carboxymethyl cellulose is prepared from sulphite softwood pulp, which embraces the softwood pulp set forth in the instant claims. The similar starting material also suggests similar viscosity values by the carboxymethyl cellulose products.

Summary

8. Claims 39 and 60-64 are rejected; Claims 1-38 and 47-59 are withdrawn from consideration as being directed to nonelected inventions.

Examiner's Telephone Number, Fax Number, and Other Information

9. For 24 hour access to patent application information 7 days per week, or for filing applications, please visit our website at www.uspto.gov and click on the button "Patent Electronic Business Center" for more information.

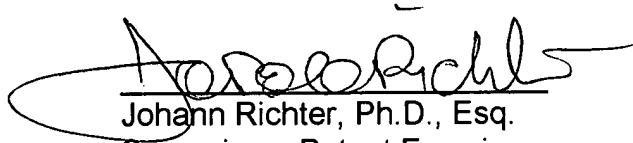
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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Everett White whose telephone number is (703) 308-4621. The examiner can normally be reached on Monday-Friday from 9:30 AM to 6:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Johann R. Richter, can be reach on (703) 308-4532. The fax phone number for this Group is (703) 308-4556.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-1235.

E.White


Johann Richter, Ph.D., Esq.
Supervisory Patent Examiner
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